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Paper No.

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**AUG 18 2004**

In re Application of:	:	<b>OFFICE OF PETITIONS</b>
ISHIDAO et al.	:	
Application No. 10/768,188	:	DECISION DISMISSING
Filed: February 2, 2004	:	PETITION UNDER
Title of Invention:	:	37 CFR 1.47(a)
SEMICONDUCTOR MEMORY DEVICE AND	:	
MANUFACTURING METHOD THEREOF	:	

This is in response to the Petition Under 37 CFR § 1.47(a), to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor, AND BE ADDRESSED TO petitions Attorney Derek L. Woods. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 2, 2004, without, a fully executed oath or declaration. The Office mailed a Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice"), on April 30, 2004, requiring *inter alia*, a properly signed oath or declaration.

In response to the Notice, Applicant files the instant wherein Applicant avers that the nonsigning inventor refuses to join in the above-identified application or cannot be found or reached after diligent effort. This assertion is supported by a statement of pertinent facts wherein Applicant avers that the Oath and Declaration and Power of Attorney and Assignment were

sent to the nonsigning inventor, who has yet to reply and can not be reached by telephone.

Applicable Law

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), where it is alleged that an applicant refuses to join an application, the applicant must establish that the nonsigning inventor was presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

Here, Applicant has sent the Declaration and Power of Attorney and Assignment, but has failed to present the inventor with the application<sup>1</sup>. A copy of the application papers should be sent to the last known address of the nonsigning inventor.

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<sup>1</sup> Applicant is advised that, where an inventor is unavailable (cannot be reached), while it is not required that the application be mailed, Petitioner must establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. A statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventor. (Emphasis supplied). See, MPEP §


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

By FAX: (703) 872-9306  
Attn: Office of Petitions

By hand: 2201 South Clark Place  
Customer Window  
Crystal Plaza Two, Lobby Room 1B03  
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0014.

  
Derek L. Woods  
Petitions Attorney  
Office of Petitions

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409.03(d). At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the non-signing inventor may reside. Copies of the results of such searches must be referred to in any renewed petition. It is important that the forthcoming communication contain statements of fact as opposed to conclusions. See, MPEP § 409.03(d).